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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,354	11/13/2000	Tetsuya Gatanaga	IRVN-007CIP2	4815

24353 7590 05/20/2003

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EXAMINER
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MURPHY, JOSEPH F

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/700,354

Applicant(s)

GATANAGA ET AL.

Examiner

Joseph F Murphy

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1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 57-61, 66, 72, 74-76, 78, 80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61, 72, 76 and 80 is/are rejected.
- 7) ☒ Claim(s) 57-60, 66, 74, 75 and 78 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Formal Matters***

Claims 57 was amended in Paper No. 15, 2/20/2003. Claims 62-65, 67-71, 73, 77, 79 stand withdrawn from consideration pursuant to 37 CFR 1.142(b). Claims 57-61, 66, 72, 74-76, 78, 80 are under consideration.

### ***Claim Objections***

Claims 57-61, 66, 72, 74-76, 78, 80 are objected to because of the following informalities: They contain subject matter directed to non-elected Groups. Applicant elected, in Paper No. 12, 6/24/2002, the Group which is drawn to a method of producing a protein wherein the encoding polynucleotide is SEQ ID NO: 9. Since claim 57 is being examined only as it is drawn to SEQ ID NO: 9, claims 60 and 66 fail to further limit claim 57, the claim which they depend, and are thus objected to. Claims 61 and 72 are of the identical scope, given the election of SEQ ID NO: 9, and are thus objected to. Claims 76, 78 and 80 also are duplicate claims in light of the election of SEQ ID NO: 9, and are thus objected to. Applicant may want to consider canceling the non-elected subject matter from the claims under consideration, while adding independent claims drawn to the non-elected subject matter, which would be withdrawn but would include all the non-elected subject matter. Appropriate correction is required.

### ***Response to Amendment***

The rejection of claims 57-61, 66, 72, 74-76, 78, 80 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter has been obviated by Applicant's amendment, and is thus withdrawn.

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The rejection of claims 57-61, 66, 72, 74-76, 78, 80 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of producing a protein encoded by the nucleic acid of SEQ ID NO: 9, does not reasonably provide enablement for a method of producing a protein which is a fragment of the protein encoded by SEQ ID NO: 9, or encoded by a nucleic acid which hybridizes to SEQ ID NO: 9, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 57-61, 66, 72, 74-76, 78, 80 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claim 57 under 35 USC 112 second paragraph, as being vague and indefinite because it is incomplete, and it is unclear what functional limitation is intended for the polypeptide produced by the claimed method, has been obviated by Applicant's amendment and is thus withdrawn.

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***Claim Rejections - 35 USC § 112 second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 61, 72, 76, 80 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record set forth in Paper No. 15, 2-20-2003.

Claims 61, 72 recites the term "stringent conditions", which is a conditional term and renders the claim indefinite. Furthermore, some nucleic acids which might hybridize under conditions of moderate stringency, for example, would fail to hybridize under conditions of high stringency. The metes and bounds of the claim thus cannot be ascertained. This rejection could be obviated by supplying specific conditions supported by the specification which Applicant considers to be "stringent". Claims 76, 80 are rejected insofar as they depend on the recitation in claim 61 of "stringent conditions". Applicant argues that the specification defines stringent hybridization conditions, however, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Since there is no indication in the claims as to what is considered "stringent hybridization" conditions, the metes and bounds of the claim cannot be determined.

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***Conclusion***

Claim 57-60, 66, 74, 75, 78 are objected to.

Claims 61, 72, 76, 80 are rejected.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245.


The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
May 14, 2003



YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600